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**REMARKS/ARGUMENT**

**Claim Rejections – 35 USC § 101**

Claims 1, 24, and claims depending from them were rejected in the office action on the grounds that they were directed to non-statutory subject matter. The applicant respectfully traverse these rejections for the claims as amended. The amended claims are directed to methods requiring affirmative, concrete, and tangible actions such as providing a funeral service, sending flowers or plants in fulfillment of a request, and making an offer. Determining whether a funeral service had been given or flowers had been sent would be subject to "yes" or "no" determination by a court presented with these issues in the context of a dispute over whether a contract for these services had been fulfilled. It is routine for courts to determine whether an offer has been made, as offer and acceptance must each be proved in the legal process of establishing that a contract has been formed between two parties.

Claims 17 and 18 were rejected on the grounds that "a display" could be composed of printed matter. The applicant respectfully traverses this rejection. The test for whether a printed matter rejection is applicable is not whether the claim limitations can be met with paper and material printed on the paper. A printed matter rejection is valid if and only if the claim as a whole is directed to material that has as its primary purpose "conveying of intelligence to a reader." See *In re Jones*, 54 C.C.P.A. 1218, 1223 (C.C.P.A. 1967). If the printed matter and the substrate interact in a functional way, then the subject matter is patentable. It should also be noted that printed matter limitations can exist in a claim that is on the whole directed to patentable subject matter. See *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). Where printed matter limitations are found in a claim that is on the whole directed to patentable subject matter, the printed matter limitations cannot be excised prior to considering novelty and non-obviousness but rather must be given full weight just as any other type of claim limitation in determining whether the claim is novel and non-obvious. See *Id.*

Claims 17 and 18 require a funeral register, which is a functional device. A funeral register has at a minimum the function of enabling attendees of a funeral to

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make a record of their attendance. A funeral register conveys to the reader its purpose, but must also provide a structure on which the user can conveniently act to communicate attendance at a funeral event. A funeral register is typically a bound volume of print with ruled spaces for entering names, but could equally well be implemented with an electronic device. A funeral register eventually provides a list of names, but would not be confused by those of ordinary skill in the art with the information contained in the list, which might be copied from the register after a funeral event.

**Claim Rejections:**

Claim 1 as originally filed was rejected as anticipated by Russel et al. (U.S. Pat. App. Pub. No. 2002/0178079). The applicant respectfully traverses this rejection on the grounds that Russel et al. does not disclose providing a funeral service, which is a requirement of claim 1, or making any selective offerings based on funeral service attendance, which is also a requirement of claim 1. In addition, claim 1 as amended requires that the reminder offered be a reminder to contact the bereaved. Russel et al. does not disclose any reminders of this type. Suggesting to funeral attendees that they contact the bereaved on the funeral anniversary and assisting them in doing so is not taught by Russel et al. The desirability of such contact is not generally known in the art and prevents the invention from being obvious in view of Russel et al.

The paragraphs of Russel et al. (page 14, par 0190-0192) cited in the office action to support the contention that Russel et al. discloses providing a funeral service relate only to informing users of what to expect from a funeral service. In its background section, Russel et al. explains that one of the problems it addresses is that acquaintances are no longer geographically clustered as they once were resulting in people from different cultures and traditions collecting for funerals. (pp. 1-2, par. 0010). Mourners want to do the right thing, but "may not know the religious or cultural traditions of the deceased." (page 2, par. 0012).

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The solution Russel et al. suggests is to provide in a website many types of information mourners may need, including the practices of specific religions. (See, e.g., page 14, par. 0181). The paragraphs cited by the Examiner are under the headings "Sample Religious Content Page" and "Catholic Beliefs, Practices and Customs Related to Mourning (Roman Catholic Church in the United States)." (page 14, par. 0182-0183). The paragraphs cited are not a do-it-yourself guide to putting on a Catholic funeral service, but a description designed to help mourners know what to expect and how to conduct themselves at the funeral. Russel et al. does not suggest that the user provide a funeral service.

The Examiner may contend, as a fall back position, that a computer terminal connected to Russel et al.'s website could be set up at a funeral parlor. This, however, is not suggested by Russel et al. While common sense suggests that such a thing could be done in principal, it does not suggest that such a thing would be done in practice. Common sense suggests a funeral home director would not consider a computer terminal set up for casual browsing by funeral attendees consistent with the decorum of a funeral home. A funeral service is a time for people to gather, pray, and speak to one another, not a time for sitting at a desk and typing eulogies. Finally, the nature of Russel et al.'s service is consistent with each attendee having their own terminal, not with every attendee sharing one terminal. A bank of terminals in a funeral home, each with an attendee intent on their own interaction with the computer, is an even greater departure from common sense, suggested neither by Russel et al. or the present application.

Another point of distinction applicable to claim 1 as amended is that the website does not offer any election targeted to a group of persons "selected based on their attendance" of a funeral service as required by the amended claim. The offerings of Russel et al. passively await the needs of mourners and their friends without targeting based on funeral attendance. Part of claim 1 is targeting the offer to attendee's of a funeral.

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Perhaps the most crucial distinction of claim 1 from Russel et al. is in the content of the reminder that must be offered to meet the limitations of claim 1. In order to infringe or anticipate claim 1 as amended, it must be established that the reminder offered is a reminder to contact the bereaved in connection with a funeral anniversary.

While providing a bereaved person with a funeral anniversary reminder of some sort at the bereaved person's request was known as shown by Russel et al. Claim 1 is distinguished by the required content of the reminder. Offering a funeral reminder service of a generic sort that the offeree may use for purposes of their own is not sufficient to meet the limitations of claim 1. Claim 1 requires an offer to be reminded to perform an action that has not been suggested by funeral homes prior to applicants work. In particular, claim 1 requires offering a funeral attendee to be reminded to contact the bereaved on the funeral anniversary. This would not be infringed by offering, for example, a bereaved person a general reminder that such a person might use to remember to place flowers on a grave annually.

Implicit in the offer required by the claim is a suggestion that offering condolences to the bereaved on the funeral anniversary is an action the recipient of the offer should consider. Such a suggestion was not known in the art prior to applicant's research. The common belief was rather that the bereaved should be allowed to get over the death and that reminding them of the death on the funeral anniversary date would be potentially tactless and inconsiderate.

Similar to amended claim 1, original claim 3, which has been cancelled, included a requirement that the reminder be a reminder to contact the bereaved. This was also rejected as anticipated by Russel et al. The portion of Russel et al. cited in this connection (page 18, par. 0227-0228) does not support that rejection. The cited portion merely states that "publication contacts" can be selected by a user. Examples of publication contacts include newspapers, magazines, and bulletin boards. The example list does not include bereaved persons.

Even if the publication list included bereaved persons, the citation of a portion of the specification mentioning contacting a bereaved person in some context could not be

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combined with an unrelated portion of the specification describing anniversary reminders to anticipate the claim without any rational for making the combination.

USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim a whole must be considered.

Interim Guidelines for Examination of Patent Application for Patent Subject Matter Eligibility, p. 9-10 (Emphasis in original) (citing *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)). The rejection divides the claim not merely into discrete elements, but into short phrases. Finding these independent phrases separately used in a reference while pointedly ignoring the context of their use does not provide a sufficient basis for asserting the claim is anticipated.

Claim 4 requires that the reminder be provided and include a suggestions for what to write in a note to the bereaved. Claim 5 requires that the reminder include guidelines for whether to contact the bereaved. Both of these claims were rejected as anticipated by Russel et al. The applicant traverses this rejection on the ground that Russel et al. is not enabling of this action. Russel et al. discloses providing sympathy cards and guidelines for what to write on the occasion of a funeral. However, one of ordinary skill in the art at the time the invention was made would not know what would be appropriate for a funeral anniversary. Even less so would one of ordinary skill in the art know what guidelines to provide on whether to contact the bereaved on a funeral anniversary. Such guidelines did not exist until applicant developed them through research.

Claim 8 requires that the offer solicit acceptance through an appropriate mark in a funeral register. The basis for rejecting this claim was not made clear in the office action, although certain paragraphs of Russell's specification are cited. The cited paragraphs are asserted to describe providing a virtual funeral service, but do not. The cited paragraphs describe providing a variety of services, none of which is a funeral service or an electronic funeral registry. Even if they did describe a funeral service carried out through the internet, this would not be sufficient to meet the limitations of

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claim 8. Russel et al. describes a user registering on a website, but the website is not a funeral register. A funeral register is a device made available by a funeral director for people visiting a funeral home to pay their respects to the deceased to record their having made the visit. It would be inappropriate and misleading for a non-attending person to record their name in a funeral register.

Claim 9 is for a method of advertising a funeral home. The method requires steps including obtaining a list of funeral service attendees and sending funeral anniversary reminders based on membership in the list. Russel et al. does not disclose either obtaining a list of funeral attendees or sending anyone an unsolicited funeral anniversary reminder. The office action notes that Russel et al. claims its method generates more newspaper ad revenue by causing longer death notices to be sent and sending the notices to more newspapers. Russel et al.'s claim of generating more newspaper ad revenue has no apparent bearing on Claim 9.

Claim 10-12 and 15 further limit claim 9 by requiring various content specific to the nature of the reminder, which is for the first person (the offeree) to contact a second person (the bereaved) on the occasion of the funeral anniversary. As elaborated above, Russel et al. neither discloses or suggests the desirability of such contact. In addition, Russel et al. and the prior art in general do not enable guidelines on whether to contact the bereaved on a funeral anniversary and what to say if such contact is made.

Claims 17 and 18 require a funeral register and a written offer for a person filling out the register to receive a funeral anniversary reminder. These claims were rejected as anticipated by Russel et al.'s disclosure of a person registering to use a website that can also provide funeral anniversary reminders. The rejection asserts that the website is a funeral register. As explained above, a funeral register is a device well known in the art with a well defined function: a mechanism for funeral attendee's to record that they have come and paid their respects. Registering on a website is an entirely different matter.

Claims 24-26 require sending flowers, identifying persons requesting flowers in connection with a funeral event, and offering those specific persons a funeral

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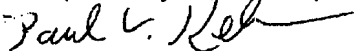
anniversary reminder. These claims were rejected on the basis that Russel et al. independently enables mourners to send flowers and request generic funeral anniversary reminders. As clarified in the amended claim, the claim requires selective offers to persons sending flowers and is not infringed by offering these two services independently side by side. Persons sending flowers in connection with a funeral have not historically also sent them on the funeral anniversary or even considered that such action would be desirable. It should also be noted that any pre-existing practice of placing flowers on a grave site annually has no bearing on the present claim, as flowers are not sent for that purpose. Placing flowers on a grave involves a personal visit to the grave site.

New claims 27-29 specify that the anniversary is a one year anniversary. As noted in applicants specification, the one year anniversary is particularly significant to the bereaved. Reminding an acquaintances of the bereaved to send condolences of the one year anniversary has particularly strong results that would not have been expected based on the prior art.

### CONCLUSION

The pending claims are believed to be in condition for allowance. Should the Examiner for any reason feel that a telephone interview would be helpful, the Examiner is invited to contact the undersigned.

Respectfully submitted,



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